REMARKS

Reconsideration of the above-identified patent application in view of the remarks following is respectfully requested.

Claims 1-9 and 18-23 are pending in the application. In the Office Action dated August 19, 2008, all claims have been rejected. The rejection is respectfully traversed.

§ 103(a) Rejections

Claims 18, 19-20 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordon (US 2003/0219513). The rejection is respectfully traversed. While not rejecting claim 1 as being unpatentable over Gordon alone, the Examiner proceeds to argue the reason for rejections vs. claim 1. Applicant interprets this as an unintentional error, with the rejection directed in fact to claim 18. The Examiner's position is that in regard to claims 1 and 18, Gordon discloses:

> *"a system that is capable of reducing human body weight, comprising an assemblage of plurality of foods placed in a carton which can be called a "portable kit", wherein said plurality of foods have at least one predetermined nutritional component which can be carbohydrate content, with said food stacked/organized in stacked levels. Once it was known to provide a plurality of foods with a predetermined nutritional content, where nutritional content are the same or varied (Applicant's emphasis), from one food to another, such as calories or carbohydrates, how one chooses to stack them in terms of their nutritional content is seen to have been an obvious matter of choice; especially, since the nutritional content of the foods would have been known".*

Applicant respectfully submits that this position is both factually wrong and reflects a misunderstanding of the invention claimed in claim 18 (and claim 1), for the following reasons:

Gordon discloses a method and a system for monitoring or controlling and recording a nutritional intake of a subject comprising providing a plurality of different types of foods packaged to contain a predetermined and substantially uniform content of at least one nutritional component; and monitoring or controlling the number of food packages consumed during a predetermined time period. Gordon makes it absolutely clear throughout his description that in every configuration of a plurality of food packages, even when the plurality of food packages contains a plurality of different types of foods (or "food units"), each of the plurality of different types of foods or food units has the predetermined and substantially uniform content of at least one nutritional component as a permanent characteristic feature. His description focuses on calories as a key nutritional component and the term "uniform content" is clearly explained in examples such as the one in paragraph [0083]:

> *According to a preferred embodiment, method 10 provides a range of food units or packages, each containing a type of food having a predetermined content of about 100 calories. The food type in each package may vary and will preferably comprise a wide range of foods from each of the food groups. For example, each package may contain a food selected from the dairy product group and may include a serving equivalent to 100 calories of skim milk, cottage cheese, yogurt or the like. The package may contain a selection from the fruit group such as an apple, banana, orange, pear, plum, grapefruit, melon or a serving of berries cherries or grapes, each substantially equivalent to 100 calories. It may contain bread or baked goods substantially equivalent to 100 calories, or a 100 calorie equivalent portion selected from the vegetable group such as a serving of asparagus, beets, tomatoes, mushrooms, carrots, zucchini, green beans, broccoli, or the like. These vegetables may be packaged raw or cooked or combined into a serving of mixed vegetables which may include a calorie controlled amount of sauce or dressing. The package may be a can or bottle containing a 100 calorie serving of a soft drink or juice. As can be seen, a wide variety of different food products, prepared in different*

> *fashions, may be selected from in order to comply with the predetermined daily calorie level.*

In other words, Gordon's invention relates to (and only to) foods (or "food units") having the same nutritional content, no matter what their arrangement is. In sharp contrast, the present invention claimed in independent claim 18 recites:

> *a. an asymmetrically shaped kit that includes a plurality of food storage units; and*
> *b. a plurality of foods having a known total carbohydrate content stored in said storage units by levels according to a carbohydrate content order, wherein each level includes foods of substantially similar carbohydrate content and wherein said substantially similar carbohydrate content varies from level to level;*

Applicant's description clearly indicates (e.g. paragraph [0016]) that the foods in the level with the largest number of foods may have zero carbohydrate content, a practical impossibility in Gordon's system (where the same nutritional content requirement would mean a zero total nutritional content for his "assembly"). Furthermore, paragraph [0024] in Applicant's disclosure summarizes the invention as follows:

> *The carbohydrate content is preferably defined by units, each food having a known number of carbohydrate units per food weight unit. The user can then freely eat the foods in the kit throughout the day. This diet does not count calories - in fact, the number of calories in the foods eaten is not important. The principle behind the system and method disclosed herein is the controlled daily intake of carbohydrates spread among a wide variety of foods, the organizing of these foods in a portable kit that has means to distinguish between the various carbohydrate content groups, and means to prevent the spoiling of these foods.*

Applicant submits that Gordon does not teach the variation of carbohydrate content from level to level in food storage units of an asymmetrically shaped kit. Gordon teaches the opposite, i.e. away from the present invention (since the levels contain foods with the same nutritional content, they have absolutely no other functional purpose than to increase the total nutritional content). Furthermore, Gordon teaches away from the present invention by focusing on purpose on the key feature that all the foods must have a predetermined and substantially uniform content of at least one nutritional component and by emphasizing calories as the key embodiment of the nutritional component, while paragraph [0024] in Applicant's disclosure clearly states that "*This diet does not count calories - in fact, the number of calories in the foods eaten is not important*".

With regard to the shape limitation in claims 18 and 23, the Examiner notes that

> *"the configuration (shape) of the claimed kit would have been a matter of choice for the person with ordinary skill in the art, absent persuasive evidence that the particular configuration of the claimed kit is significant. Also, rearranging/shifting foods in the kit would not have modified the operation of the claimed kit. Further in this regard, it is noted that the particular shape of the kit, and arrangement of the foods in the kit, would have been a matter of personal choice and design".*

Applicant reiterates his rebuttal of Examiner's position, a rebuttal presented in a previous Response and which the Examiner seems to have ignored by finding new grounds for rejection and therefore considering previous Applicant arguments as moot. As argued previously by Applicant, the configuration of the kit is not a matter of choice but of a definite design: levels include less and less foods as the food carbohydrate content increases. As argued in a previous Response, the different (varied) carbohydrate content of the food in different levels claimed in claim 18 has a criticality explained by Applicant in detail:

> *The configuration of the claimed kit is an essential inventive feature in that the amount of foods (and containers) in each level decreases from foods with low or zero carbohydrate content to foods with high*

carbohydrate content, when the total carbohydrate content of the kit is predetermined. The configuration allows for easy understanding and remembering of which foods have which carbohydrate content (zero-low, medium or high)., see e.g. specification p. 11, lines 7-9 and 12-20.

Rearranging the foods in a kit would certainly modify the operation of the kit: for example, in the arrangement recited in claim 3, any change between levels will increase the total carbohydrate content of the kit, defeating the purpose of weight loss by providing a total carbohydrate content larger than the predetermined amount. No prior art structure performs the intended use of the present invention, i.e. a diet regimen based on a defined, limited carbohydrate content, based on foods organized in a kit according to carbohydrate content (see specification, p. 11, lines 10-20).

MPEP 2143.03 makes clear that: "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." The Examiner has failed to meet this burden. Although the recent Supreme Court decision in KSR International Co. v. Teleflex Inc. et al, 550 U.S. __ (2007) has relaxed the "TSM" test for combining references, it made no change in the requirement that all claim limitations must be taught or suggested by the prior art. The Supreme Court noted with approval In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006), which stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

As indicated, Gordon does not teach foods with varied nutritional content being arranged in any common arrangement such as a kit, but teaches only foods or food units with the same nutritional content. Gordon does not teach foods with different carbohydrate content arranged in different levels of a kit. Gordon's "levels" have no other purpose than to increase the total amount of nutritional content, by increasing the number of stackable same units. Since Gordon does not actually teach or suggest all the limitations of claim 18 (and claim 1), Applicant respectfully submits that the Examiner has failed even to state a case of *prima facie* obviousness re claim 18 (and claim 1). Moreover, as argued above, Gordon teaches away from the invention. *Mutatis mutandis*, the failure to state a case of *prima facie* obviousness and

the teaching away from the invention extend to all claims dependent from claim 18, including claims 19-20 and 23.

Claims 1-9 and 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordon (US 2003/0219513) in view of Rilling et al (US 5,582,028). The rejection is respectfully traversed.

In regards to claim 1, the Examiner reiterates the reasons for rejection mentioned above re. claim 18 and further states that while spoiling means are not disclosed by Gordon they are disclosed by Rilling et al. Applicant submits that while disclosing such means, Rilling et al. fail to disclose any of the limitations recited in claims 1-9, 21-22 which are missing in Gordon. Thus, Rilling et al. do not disclose foods with varied carbohydrate content being arranged in any common arrangement such as a kit by levels according to a carbohydrate content order, wherein each level includes foods of substantially similar carbohydrate content and wherein said substantially similar carbohydrate content varies from level to level. Since neither Gordon not Rilling et al teach or suggest all of the limitations of claim 1 (or claim 18), Applicant respectfully submits that the Examiner has failed even to state a case of *prima facie* obviousness re claim 1 (or 18) based on the combination of Gordon and Rilling et al. Moreover, as argued above, Gordon teaches away from the invention and therefore the combination of Gordon and Rilling et al teaches away from the invention as well. *Mutatis mutandis*, the failure to state a case of *prima facie* obviousness and the teaching away from the invention extend to all claims dependent from claim 1, including claims 2-9. Moreover, similar arguments apply to claims 21, 22, which depend from claim 18.

In view of the above amendments and remarks it is respectfully submitted that Claims 1-9 and 18-23 are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,

Mark M. Friedman
Attorney for Applicant
Registration No. 33,883

Date: October 26, 2008